

REMARKS

Reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks are respectfully requested.

Currently, claims 41-65, 68-108, and 110-113 remain pending including independent claims 41, 70, 83 and 113. In the initial Office Action, claims 46, 47, 53, 54, 79, 80, 88, 89, 96 and 97 were objected to as being of improper dependent form. In response, claims 46, 47, 79, 80, 88 and 89 have been amended in order to provide the claims with a more definite structural limitation. For instance, claim 46 now requires that the treated discrete areas comprise multiple layers of the film-forming composition. The treated areas comprising "multiple layers" are believed to be a structural limitation and therefore proper subject matter for a dependent claim. Applicants also submit that claims 88, 89, 96 and 97 are also in proper dependent form.

In the Office Action, claims 67 and 110 were also objected to as drawn to an intended use of a paper or smoking article. In response, claim 67 has been canceled. Claim 110, however, is directed to a smoking article that includes treated discrete areas that cause the smoking article to self-extinguish when in contact with an adjacent substrate. Applicants submit that claim 110 is in proper dependent form and is not merely an intended use. For example, requiring a smoking article to self-extinguish when in contact with an adjacent substrate serves to characterize the properties of the treated discrete areas. Thus, it is believed that claim 110 is proper for purposes of 37 C.F.R. 1.75(c).

Claims 66 and 109 were objected to under 35 U.S.C. §112. Although Applicants do not acquiesce in the rejection, claims 66 and 109 have been canceled.

Finally, in the Office Action, all of the claims were rejected under 35 U.S.C. §103 over Peterson in view of Hampl '755 and Hampl '860. In response, Applicants submit that none of the above references either alone or in combination teach a paper wrapper or a smoking article containing a paper wrapper wherein the paper wrapper has a permeability of greater than about 60 Coresta and has treated discrete areas having a permeability of less than about 25 Coresta and/or includes treated discrete areas having a BMI of less than about 5 cm⁻¹.

In the Office Action, it was admitted that none of the references disclose a paper wrapper having a permeability of greater than about 60 Coresta. The Office Action points out, however, that Peterson teaches that the wrapper may include any manner of commercially available cigarette wrapper and that using a wrapper having a permeability greater than about 60 Coresta would have been an "obvious modification to the Peterson process at the time of the invention".

By way of background, please note that the wrapping paper of a smoking article is primarily responsible for controlling various properties of the smoking article. For instance, the wrapper, as opposed to the tobacco filler, primarily controls the puff count of the smoking article, the tar delivery, the carbon monoxide delivery, and the amount of mainstream smoke and sidestream smoke that is generated by the smoking article. The paper wrapper can also have a significant impact upon the taste of the smoking article to the smoker. In order to control the above properties, conventional cigarettes are typically made with paper wrappers having a permeability of less than about 60 Coresta. Increasing the permeability can have many adverse effects upon the smoking article. Greater permeability, for instance, may significantly decrease the puff count and can dilute the mainstream smoke to a point that the smoking article may be rejected by consumers.

In this regard, the '753 patent discloses the use of conventional wrappers. As stated in the examples, the wrappers have a permeability of about 32 Coresta.

The present inventors, on the other hand, have discovered that when applying a film-forming composition to a paper wrapper in order to form treated discrete areas, various advantages and improvements can be realized by using wrappers having a permeability of greater than 60 Coresta. The present inventors have discovered that by using wrappers having a relatively high permeability, smoking articles can be formed in some embodiments that are better suited to passing various ignition tests while also not having a tendency to self-extinguish when allowed to burn in the free air.

In addition, the present inventors have also discovered that the higher permeability can be used in conjunction with the treated discrete areas while maintaining puff counts, tar delivery, and other characteristics within desired ranges.

In view of the above, one skilled in the art would not have been motivated to increase the permeability of the base paper above 60 Coresta in Peterson. The above is simply not an "obvious modification" as asserted in the Office Action.

In fact, in the parent application, which issued as U.S. Patent No. 6,725,867, claims 40-49 and 51 pending in the previous application were indicated as being allowable because:

the instant claims are deemed to be directed to a nonobvious improvement over the invention patented in the Peterson, et al. reference. The improvement comprises the paper wrapper having a relatively high permeability, of at least 60 CORESTA, in the untreated areas, but having a reduced permeability, sufficient to reduce ignition proclivity, in the treated areas.

In summary, Applicants submit that the present application is in complete condition for allowance and favorable action is therefore respectfully requested. Should any issues remain after consideration of this response, however, then Examiner Lazorcik is invited and encouraged to telephone the undersigned at his convenience.

Respectfully submitted,

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